

3



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,162	09/25/2003	Barry J. Gilhuly	555255012579	7030

7590 04/22/2005

David B. Cochran, Esq.
JONES DAY
901 Lakeside Avenue, North Point
Cleveland, OH 44114

EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,162

Applicant(s)

GILHULY ET AL.

Examiner

Bradley Edelman

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10 pages total.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is a first action on the merits of this application. Claims 1-54 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-7, 8, 9-28, 29-45, 46-53, and 54 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 8-9, 24-43, 46-62, 71-78, and 81 of copending Application No. 09/928,983. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '983 application contain all of the limitations of the claims of the present application, and as such, anticipate the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In considering these claims, the following table maps out the corresponding claims in the two applications. The claims are identical, except that the claims in the '983 application include a step of "encrypting" data items at the redirector host system before forwarding the data items to the mobile device (and correspondingly decrypting encrypted reply messages sent from the mobile device and received at the host system). The '983 claims thus include all of the limitations of the present application and therefore anticipates the claims in the present application.

Application No. 09/928,983	Present Application
<p>Claim 1:</p> <p>A method of redirecting data items from a messaging host system to a user's mobile device, comprising the steps of:</p> <ul style="list-style-type: none">detecting a new data item for the user at the messaging host system;forwarding a copy of the new data item to a redirector host system;determining whether the new data item should be redirected from the redirector host system to the user's mobile device; <p>and</p>	<p>Claim 1:</p> <p>A method of redirecting data items from a messaging host system to a user's mobile device, comprising the steps of:</p> <ul style="list-style-type: none">detecting a new data item for the user at the messaging host system;forwarding a copy of the new data item to a redirector host system;determining whether the new data item should be redirected from the redirector host system to the user's mobile device; <p>and</p>

if the new data item should be redirected, then <u>encrypting the new data item to form an encrypted new data item;</u> <u>and</u> packaging the <u>encrypted</u> new data item into an electronic envelope and transmitting the electronic envelope to the user's mobile device.	if the new data item should be redirected, then packaging the new data item into an electronic envelope and transmitting the electronic envelope to the user's mobile device.
Claims 2-7	Claims 2-7
Claims 8 & 9	Claim 8
Claims 24-43	Claims 9-28
Claims 46-62	Claims 29-45
Claims 71-78	Claims 46-53
Claim 81	Claim 54

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2153

2. Claims 1-24, 31, 32, 34, 35, 37-39, 42, 43, 47-51, and 54 are rejected under 35

U.S.C. 102(b) as being anticipated by

AirMobile Communication Server Guide ("AirMobile Software for Lotus cc:Mail Wireless," Motorola Publication, 1995, hereinafter "AirMobile")

In considering claim 1, AirMobile discloses the claimed redirection method including detecting a new data item for the user at the messaging host system (cc:Mail Post Office server, Fig. 1), forwarding a copy of the data item to a redirector host system (AirMobile Wireless for cc:Mail Server, Fig. 1), determining if the new data item should be redirected from the redirector host system to the user's mobile device, and if so, then packaging the data item in an electronic envelope and transmitting the electronic envelope to the user's mobile device (pp. 10-11, describing the messaging system and the filtering of messages at the redirector host system, see also pp. 25-26, 35).

Claims 2-5 are disclosed on page 10 of AirMobile.

In considering claims 6-7, AirMobile further discloses the step of configuring filtering rules and a user profile database at the redirector host system and allowing a user or administrator to remotely configure the filters and database remotely (pp. 11-12).

Claim 8 is further disclosed by AirMobile (see AirMobile, pp. 26-27, wherein an electronic envelope is inherently necessary to send messages between the host and the mobile device).

In considering claim 9 AirMobile further discloses sending replies from the mobile device to the redirector host system (p. 26, describing messages sent by the mobile device).

In considering claim 10, the messages sent from the mobile device to the redirector server will necessarily be addressed using the address of the redirector host system.

Claims 11-12 disclose the analogous reverse steps as claim 1, and thus are rejected under the same rationale as claim 1.

In considering claim 13, AirMobile will necessarily complete the claimed steps of receiving a reply received at the redirector host system, reconfiguring address information associated with the reply, and sending the reconfigured reply data to a destination using an electronic address included in the reply data item (i.e. the messages sent from the mobile device are intended for outside recipients, so must include the address of those recipients and must have addresses reconfigured upon redirection at the redirection host system).

In considering claim 14, AirMobile further discloses the claimed gateway, and thus sending messages in the electronic envelope through the gateway (Fig. 1, wherein the "Mobidem" serves as the gateway).

Claims 15-24 are disclosed in the same sections of AirMobile discussed previously.

Claims 31 and 32 are disclosed on page 17 of AirMobile.

Claims 34, 35, 37-39, 42, 43, 47-51, and 54 are disclosed in the same sections of AirMobile discussed previously and are rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25-28, 40, 41, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, in view of Nelson (U.S. Patent No. 6,061,718).

In considering claims 25-26, AirMobile does not disclose that the e-mail system is run by an ISP. Nonetheless, it is well known to use e-mail over the Internet on an e-mail service run by an ISP, as evidenced by Nelson (Nelson, col. 5, line 65 – col. 6, line 4). Thus, it would have been obvious for the e-mail system taught by AirMobile to be run by an ISP because that would increase business with the ISP and would allow users to access mail from anywhere in the world.

In considering claim 27 and 40, the combined system of AirMobile and Nelson will perform the steps of including a forwarding database for detecting whether new data items received at the ISP mail server should be forwarded to the redirector host system and for determining the address of the redirector host system (AirMobile, p. 13, "Note").

In considering claims 28, 41, and 44 the combined system of AirMobile and Nelson will necessarily connect the messaging host system (i.e. ISP server) and redirector host system over the Internet.

4. Claims 29, 30, 36, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, in view of Birrell et al. (U.S. Patent No. 6,185,551, hereinafter "Birrell").

In considering claims 29, 30, 36, 52, and 53, AirMobile discloses configuring the filtering rules and profile database using an interface, but does not disclose using a web-based interface. Nonetheless, the use of web-based interfaces for e-mail systems

is well known, as evidenced by Birrell (see title: "Web-based electronic mail service..."). It would have been obvious to use a web-based system as the interface in AirMobile because the Web is ubiquitous and accessible worldwide.

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, in view of LookSmart ("Motorola Brings AirMobile Software Products to the DCPD Network; Motorola Provides Mobile Corporate cc:Mail Users with Flexibility to Use Any Major Wireless Data Network," Business Wire, January 1996).

In considering claim 33, LookSmart describes that AirMobile uses compression. It would have been obvious to include compression in the AirMobile system to save network bandwidth.

6. Claims 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, in view of Infotech ("The Perils of E-Mail: Unsolicited Messages!" Infotech Update, New York, August 1997).

In considering claim 45, AirMobile discloses at the host system a program for transmitting user data items and a forwarding file containing a list of authorized users of the system, and the predetermined address to which the messaging host system will forward each user's data items (all of this is inherently part of the PostOffice server in order to forward messages received at the PostOffice server to the appropriate AirMobile server; see Fig. 1, pp. 11-13). However, AirMobile does not explicitly state what program is used for the message forwarding, and thus does not disclose a

"sendmail" program. Nonetheless, sendmail programs for message forwarding are well known, as evidenced by Infotech (see p. 1, last paragraph). It would have been obvious to use the well-known sendmail program to forward the messages in the AirMobile system to avoid the need to create an entirely new mail forwarding program.

In considering claim 46, the PostOffice message host system taught AirMobile will necessarily store the data items of users having accounts on the messaging host system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Bradley Edelman". The signature is written in a cursive, flowing style.

BE
April 13, 2005